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In re Application of: Nonaka, et al.	)
Application No. 09/726,564	)
Attorney Docket No. P107156-00031	)
Filed: December 01, 2000	)
For: METHOD AND SYSTEM FOR	)
RECORDING AND REPRODUCING	)
INFORMATION DATA	)

DECISION ON PETITION TO  
WITHDRAW HOLDING OF  
ABANDONMENT UNDER 37 CFR  
§1.181

This is a decision on the petition filed January 13, 2005, to withdraw the holding of abandonment of the above-identified application, under 37 C.F.R. §1.181.

The instant application was indicated to be abandoned for failure to properly respond to the Office action (Non-final Rejection) mailed April 21, 2004. A Notice of Abandonment was mailed on December 14, 2004.

The Petition is **DISMISSED**.

**Recent Prosecution History**

On April 21, 2004, a Non-Final Office action was mailed, setting forth a three-month shortened statutory period for response.

On December 14, 2004, a Notice of Abandonment was mailed.

On January 13, 2005, the instant petition was filed, along with a notification of change of address.

On February 03, 2006, a request for reconstruction and status letter were filed.

**Relief Requested**

The instant petition requests the following relief: withdrawal of the holding of abandonment and remailing of a new non-final Office action.

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. *Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.*

The petition filed on January 13, 2005 includes elements (1) and (2). No fee under 37 C.F.R. §1.181 is required for this petition.

### **Basis of Opinion**

#### **37 CFR §1.134 Time period for reply to an Office action.**

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. *Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.*

#### **35 U.S.C. 133 Time for prosecuting application.**

*Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it is shown to the satisfaction of the Director that such delay was unavoidable.*

#### **37 C.F.R. §1.135 Abandonment for failure to reply within time period.**

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 ..., the application will become abandoned unless an Office action indicates otherwise.

(b) *Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require.* The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

### **403 [R-3] Correspondence — With Whom Held**

#### **I. > CUSTOMER NUMBER PRACTICE**

Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number.

The following forms are suggested for use with the Customer Number practice:

(C) the “Change of Correspondence Address, Application ” (PTO /SB /122) to change the correspondence address of an individual application to the address associated with a Customer Number.

**The Office will also accept requests submitted electronically via a computer-readable diskette to **\*\*change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number\*\***.** < Such electronic requests must be submitted in the manner set forth in the Notice entitled “Extension of the Payor Number Practice (through “Customer

Numbers”) to Matters Involving Pending Patent Applications,” published in the Federal Register at 61 FR 54622, 54623-24 (October 21, 1996), and in the Official Gazette at 1191 O. G. 187, 188-89 (October 29, 1996). >**Note that such electronic requests are no longer accepted to change the power of attorney in a patent application or patent. See the notice entitled "Notice of Elimination of Batch Update Practice to Change Power of Attorney," published in the Official Gazette at 1272 O.G. 24 (July 1, 2003).**<

**711.03(c) [R-3] Petitions Relating to Abandonment**

***The following do not constitute proper notification of a change in correspondence address:***

***(B) the notification on a paper listing plural applications as being affected*** (except as provided for under the Customer Number practice - see MPEP § 403).

**Analysis**

In support to the petition filed on January 13, 2005, Petitioner provides the following evidence: a statement that the Office action mailed April 21, 2004 was not received; a copy of the notice of customer number record change mailed January 31, 2001; an email (dated May 22, 2001) regarding an error report for customer number 04372; and a spreadsheet listing all Serial Numbers associated with the error report.

In order to clarify the prosecution record, a brief analysis will be proffered. Prior to the mailing of a Non-final Office action (mailed April 21, 2004), Applicant indicates that a previously submitted email request (on or about May 22, 2001) batch or spreadsheet listing of applications with a requested change of address associated with customer number 04372, should have been entered and the file updated to reflect such changes. Therefore, the mailing of the Non-final Office action to the former address of record i.e. NIKAIDO, MARMELSTEIN, MURRAY & ORAM LLP, Metropolitan Square, G Street Lobby – Suite 330, 655 Fifteenth Street, N.W., Washington, DC 20005-5701, was in error as supported by the evidence provided with the instant petition.

Irregardless, had the batch or spreadsheet list of applications emailed with the requested change of correspondence address been received prior to the mailing of the Non-final action rejection, in accordance with the citations above, such request would have been deemed improper. The Office does <did> not accept change in correspondence address emailed or filed *in paper form* listing plural applications associated with a customer number, as shown in the evidence provided with the instant petition (see MPEP 403 and 711.03(c)). Note, the Office had accepted requests ***submitted electronically via a computer-readable diskette*** to change the correspondence address of a list of applications or patents but that such requests are no longer accepted (1272 O.G. 24 (July 1, 2003)). Therefore, even though the email may have been received, the correspondence address would not have been changed in accordance with the request emailed on or about May 22, 2001. Note, the notice of customer number record change (dated January 31, 2001) filed as evidence with the instant petition, lacks identification to the instant application Serial Number (i.e. 09/726,564), therefore does not serve as evidence in support of the instant application. Further, there is no record of the mailing of a notice of customer number change in the prosecution record of the instant application.

In further accordance with MPEP §711.03(c), the showing required to establish nonreceipt of an Office action includes the following:

- 1) *a statement from practitioner that the Office action was not received;*
- 2) *a statement from practitioner that the file jacket and docket records were searched;*
- 3) *a copy of the docket record at the address of record; and*
- 4) *a reference to the docket record in the practitioner's statement.*

[Emphasis added.]

The petition fails to fully comply with requirements 2-4 set forth above. The evidence submitted has not overcome the presumption of receipt.

The copy of the docket record where the non-received Office communication would have been entered had it been received and docketed, must be attached to *and* referenced in practitioner's statement. The docket record identified above is also required to be a docket record showing all actions due by the entire firm at and around the due date for response, not counting any possible extensions of time. *The attorney must also have been at the address of record at the time the action was mailed or have filed a (proper and) timely Change of Correspondence address.*

### Decision

The statutory time period for reply under 37 CFR §1.134 (sixth months from the mailing of the Non-final Office action rejection) expired on October 21, 2004, prior to the mailing of the Notice of Abandonment on December 14, 2004, and since no response to the Office action of April 21, 2004 has been received, the holding of abandonment is maintained and deemed to be proper in accordance with 35 U.S.C. 133 and 37 CFR §1.135.

Accordingly, the Non-final Office action was in fact mailed to the correct *address of record* and since Petitioner has failed to meet the requirements under MPEP 711.03(c) to establish nonreceipt, the petition to withdraw the holding of abandonment is **DISMISSED**.

If petitioner desires further review of this decision, petitioner should file a Request for Reconsideration within two (2) months of the mailing date of this decision. Alternately, Applicant may wish to file a petition to revive under 37 CFR §1.137(a) (unavoidable delay) or 37 CFR §1.137(b) (unintentional delay) as discussed below.

#### I. Unavoidable Delay

A grantable petition to revive an abandoned application under 37 CFR §1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in §1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

The showing of requirements can be met by submission of a statement of facts establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR §1.137(b) might be appropriate.

## II. Unintentional Delay

A grantable petition to revive an abandoned application under 37 CFR §1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in §1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

The required items, including appropriate fee, should be promptly submitted under a cover letter entitled "Petition to Revive under 37 CFR §1.137(a) or (b)", as deemed appropriate.

Telephone inquiries should be directed to the undersigned on (571) 272-3595.



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